



Appeal Brief
Application No. 09/529,638
Attorney's Docket No. 000500-252
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Olle Carlbark et al.) Group Art Unit: 3761
Application No.: 09/529,638) Examiner: Catherine L. Anderson
Filed: June 5, 2000) Confirmation No.: 9552
For: A WAIST BELT FOR ABSORBENT) Appeal No.:
GARMENTS)

Mail Stop APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

This appeal is from the decision of the Primary Examiner dated November 2, 2004, finally rejecting Claims 21-25, which are reproduced as an Appendix to this brief.

A check covering the \$500.00 Government fee is being filed herewith.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

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I. Real Party in Interest

The real party in interest with respect to this application is SCA Hygiene Products AB, the assignee of record in this application by virtue of the Assignment submitted on June 5, 2000.

II. Related Appeals and Interferences

There are no other prior or pending appeals, interferences or judicial proceedings known to the Appellants, the Appellants' legal representative, or the assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

III. Status of Claims

The claims currently pending in this application are Claims 4-30. Claims 4, 5, 6, 10, 16, 21, and 26 are independent. Claims 4-20 and 26-30 are allowed. Claims 21-25 are finally rejected.

IV. Status of Amendments

There are no amendments submitted herewith.

V. Summary of Claimed Subject Matter

The embodiment at issue is directed to a combination of features directed to a garment comprising an absorbent part and two separate waist belts which have a longitudinal direction, a cross-direction, longitudinally extending edge parts and a longitudinally extending interior part that is arranged between the longitudinally extending edge parts. The belts extend generally in the longitudinal direction. One end of each of the two separate belts is permanently fastened directly or indirectly to the absorbent part, and opposite ends of each of the two separate belts extend in respective directions from said absorbent part and are adapted to be fastened together around a wearer of the garment. The belts have a stiffening material that forms a stiffness that varies in the cross-direction of the belts, wherein the stiffness that varies has an extension in the longitudinal direction, and wherein a piece at the end of at least one of the belts is free from stiffening material.

A number of advantages are derived from the claimed belts having a stiffening material that forms a stiffness that varies in the cross-direction of the belts, wherein the stiffness that varies has an extension in the longitudinal direction.

As described beginning on page 3, line 22 of the present specification, by configuring the belt to include a stiffening material with a stiffness which is greater in a longitudinally extending central part of the belt than in at least one longitudinally extending edge-part of the belt, there is provided a belt whose stiffness is sufficient to avoid unwanted deformation while, at the same time, providing a soft belt edge which is comfortable to the user. Where the belt has a low degree of stiffness, it can be adapted to the shape of the wearer's body without impairing wearer comfort.

Beginning on page 3, line 34 it is described that one way of varying the stiffness formed by the stiffening material is to configure the cross sectional area of the stiffening material so that it is smaller at the edge-parts of the belt than at the central part thereof (Fig. 2). The thicker central portion of the stiffening material is stiffer than the side portions of the stiffening material. Thus, any stiffness formed by the stiffening material varies in the cross-direction.

Also, as shown in Fig. 3 and described beginning on page 7, line 13 of the present specification, another way to create varying stiffness of the stiffening material is to configure the belt to include a plurality of mutually adjacent stiffening materials 9, 10, 11, 12, 13, 14 and 15 having mutually different stiffness. The stiffening materials near the central part of the belt are stiffer than the stiffening materials near the edge-parts of the belt, thereby varying the stiffness in the cross-direction.

As described on page 8, lines 18-24, it may be appropriate to leave a piece of each end of the belt free from stiffening material to facilitate fastening the ends of the belt together, for example, with buttons.

A. Independent Claim 21

A garment comprising an absorbent part and two separate waist belts which have a longitudinal direction, a cross-direction, longitudinally extending edge parts and a longitudinally extending interior part that is arranged between the longitudinally extending edge parts, wherein said belts extend generally in said longitudinal direction, one end of each of the two separate belts is permanently fastened directly or indirectly to the absorbent part, and opposite ends of each of the two separate

belts extend in respective directions from said absorbent part and are adapted to be fastened together around a wearer of the garment, which belts have a stiffening material that forms a stiffness that varies in the cross-direction of the belts, wherein the stiffness that varies has an extension in the longitudinal direction, and wherein a piece at an end of at least one of the belts is free from stiffening material.

VI. Grounds of Rejection to be Reviewed

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Statutory Invention Registration No. H1440, hereinafter *New*, in view of U.S. Patent No. 5,706,524, hereinafter *Herrin*.

A. H1440 (*New*)

New describes a fitted belt for an absorbent garment. The waist margins 32 and 34 of a disposable assembly 14 are attached to a belt 12 which encircles a waist of a wearer. The belt 12 is bounded by two spaced apart laterally extending edges which define a width of the belt. The belt is generally arcuate in shape and has a curvilinear length taken generally midway between the laterally extending edges (column 9, line 63 - column 10, line 23). The focus of *New* is to provide a better fitting belt that discretely conforms to the contours of the wearer and is less noticeable under clothing. Therefore, the waistbands of *New* conspicuously lack any additional material that could increase thickness of the waistband, such as elastic elements.

B. U.S. Patent No. 5,706,524 (*Herrin*)

Herrin is directed to a disposable undergarment waistband that attaches and detaches to a disposable undergarment panel. The waistband is

secured to an upper peripheral end portion of the disposable undergarment panel. The belt portions do not attach to each other, but rather connect between the front and rear portions of the disposable undergarment. As shown in Figs. 4-6, the waistband 30 has a first elongate layer 31 and a second elongate layer 32. A plurality of identical elongate elastic strips 33 are disposed between the first elongate layer 31 and the second elongate layer 32. The elongate strips 33 extend in the same direction as the belt. The focus of *Herrin* is the easy manufacture of the waistband having elastic strips 33 positioned within the sheets 31, 32.

C. Rejection

The Official Action finally rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over *New* in view of *Herrin*. On page two of the Official Action dated November 2, 2004, it is stated that “*New* discloses all aspects of the claimed invention with the exception of stiffening elements.” It is further stated that “*Herrin* discloses a garment having waist belts 30 that have a stiffening material 33, as shown in figure 4, that varies in the cross-direction of the belts 30.” The Examiner proposes that it would have been obvious to modify *New* to include a belt having *Herrin*’s elastic strips 33.

VII. Argument

A. The rejection of Claim 21 under 35 U.S.C. § 103(a) over *New* in view of *Herrin* is in error for at least the reasons set forth below.

At the outset, it should be noted that MPEP § 2143 clearly defines that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met: 1) there must be some suggestion or motivation, either in the

references or in the knowledge generally available, to modify or combine the reference teaching, 2) there must be a reasonable expectation of success, and 3) the prior art references must teach or suggest all the claim limitations.

In other words, it is the Examiner's responsibility to provide reasons why: 1) a skilled person would have looked toward *Herrin* for suggestions for modifying *New*, and 2) that *Herrin* would have directed a skilled person to modify *New* to include *Herrin*'s elastic strips in its waistband.

The Examiner has not shown why a skilled person would have looked toward Herrin for direction in modifying New.

According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the garment of *New* in view of *Herrin*. However, there are significant differences between the disclosures of *New* and *Herrin* that would have prevented a skilled person from using *Herrin*'s disclosure to modify *New*.

For example, incorporating *Herrin*'s elastics in *New* would have destroyed *New*'s purpose. *New* is concerned with a belt having particularly shaped laterally extending edges, and provides a preferred formula for determining the belts which meet the desired criteria (column 12, line 66 – column 14, line 55). *New*'s belt has a means for causing one laterally extending edge to be longer than that of the other laterally extending edge when the belt is encircled about a wearer. The belt is generally arcuate in shape and has a curvilinear length (column 10, lines 17-19). This configuration allows *New*'s article to better fit and more discretely conform to the contours of the user, thereby being less noticeable under one's clothing.

In contrast, *Herrin* is concerned with a disposable undergarment waistband having elastic elements that is easily and economically produced. In use, *Herrin*'s belts are secured to an upper peripheral end portion of a disposable undergarment panel. The belts do not attach to each other; but rather attach to the upper peripheral portions of the undergarment panel on both ends and fastening means are provided at the ends of the belts. *Herrin*'s belt is purely rectangular in shape.

As noted earlier, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. However, no such motivation is found here. The belt of *New* is constructed in a particular way to obtain certain advantages such as conforming better to the contours of the wearer so that the article is less noticeable under clothing (column 12-14). *New*'s purpose would be destroyed by including additional elements in the waistband. In addition, the specifically incorporated arcuate design of *New*'s belts would be destroyed by incorporating elastics in it. The purposes of *New* and *Herrin* are diametrically opposed and by modifying the belts shown in *New* to include the elastic strips of *Herrin* would defeat the advantages taught by *New*. Therefore, one of skill in the art would not have been motivated to make modifications of *New* in view of *Herrin* as suggested by the Examiner.

It is reminded that “[t]he test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art...” MPEP § 2143.01. Also, “the examiner must weight the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another.” *Id.* Further, “[i]f the proposed

modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.02.

For these reason, the Examiner's rejection based on the modification of *New* in view of *Herrin* cannot be allowed to stand.

The Examiner has not established a prima facie case for modifying New to include every claimed feature.

Even if a skilled person had modified *New*'s article in view of *Herrin*, there still would have been no motivation to include elastic strips 33 of *Herrin* in the *New*'s belt. As shown in Figs. 1, 3-6, 9 and 10 in *New*, no elastic elements are provided in the belts 12, 12' or 12". Figs. 7 and 8 show elastic segments 50", 52" in the waist portion of the article that is positioned near the user's stomach and lower back, not on a belt portion that fits around the user's sides as shown in *Herrin*. Therefore, were one to modify *New* in view of *Herrin*, they would be directed to include *Herrin*'s elastic strips in the waist portion of the article, as shown in Figs. 7 and 8, not in the belt portion where they would be more conspicuous.

Further, the embodiments shown in Figs. 7 and 8 are not at all similar to the claimed article, at least because the waistbands shown in Figs. 7 and 8 are not adapted to be fastened together around a wearer of the garment. If *New*'s only embodiment that includes elastics in the waist area does not include waistbands as claimed, how then could one conclude that a skilled person would have modified *New* to include every claimed feature?

New and *Herrin*, alone, or in combination, would not have led one of skill in the art to the garment as defined in the rejected claims given the lack of motivation to combine the patents, and further, even if one were to combine the patents the claimed article would not result. In view thereof, Applicants respectfully submit that this rejection of Claim 21 should not be allowed to stand.

Conclusion

For the reasons discussed above, Appellant respectfully submits that the Examiner's decision finally rejecting Claim 21 and dependent Claims 22-25 which depend from Claim 21, should be reversed and such action is earnestly solicited.

Respectfully submitted,

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CLAIMS APPENDIX

TheAppealed Claims

21. (previously presented) A garment comprising an absorbent part and two separate waist belts which have a longitudinal direction, a cross-direction, longitudinally extending edge parts and a longitudinally extending interior part that is arranged between the longitudinally extending edge parts, wherein said belts extend generally in said longitudinal direction, one end of each of the two separate belts is permanently fastened directly or indirectly to the absorbent part, and opposite ends of each of the two separate belts extend in respective directions from said absorbent parts and are adapted to be fastened together around a wearer of the garment, which belts have a stiffening material that forms a stiffness that varies in the cross-direction of the belts, wherein the stiffness that varies has an extension in the longitudinal direction, and wherein a piece at an end of at least one of the belts is free from stiffening material.

22. (previously presented) The garment of claim 21, wherein the stiffness that varies has an extension that essentially coincides with the length of the belts.

23. (previously presented) The garment of claim 21, wherein the belts fasten with releasable fasteners.

24. (previously presented) The garment of claim 21, wherein one end of the absorbent part is elastic.

25. (previously presented) The garment of claim 21, wherein a piece at an end of both of the belt is free from stiffening material.